



*Sullivan*  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YASUhide TACHI et al

Serial No. 024,111

Group: 125

Filed: March 26, 1979

Examiner: Roberts

For: NOVEL HYDROCORTISONE DERIVATIVE

RESPONSE TO PAPER NO. 14

Honorable Commissioner of Patents and Trademarks  
Washington, D. C. 20231

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GROUP 120

Sir:

The following remarks are in response to the  
Examiner's office action dated July 3, 1980.

The sole remaining rejection, that of claim 1 under  
35 USC 103 over Ercoli et al in combination with Elks et al (2),  
is respectfully traversed. It is submitted that the issue of  
patentability posed by these references has been reduced to the  
issue of whether or not the ten-fold superiority in therapeutic  
effectiveness of applicants' claimed compound over the closest  
prior art compound, i.e. the 17, 21-diester of hydrocortisone,  
disclosed by Ercoli et al at col. 4, line 49, would have been  
expected from a reading of the references. Applicants readily  
concede that if the superiority would have been expected from a  
reading of the references then the showing represented by the pre-  
viously submitted declaration would not serve to overcome the prima  
facie case of obviousness. However, applicants submit that the  
ten-fold superiority possessed by their compound which they have  
proven would not have been expected from a reading of the references  
of record.

Before proceeding to what the undersigned regards as  
the real issue of record, a few comments are in order with regard